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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,589

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Jonathan S. Spigel

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EXAMINER

FIELDS, BENJAMIN S

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3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,589	<b>Applicant(s)</b> SPIRGEL ET AL.	
	<b>Examiner</b> BENJAMIN S. FIELDS	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u>                                    | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :23 January 2004; 6 May 2004; 19 May 2005; 19 November 2007.

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-72 of this application conflict with Claims 1-10 of Application No.'s 11/236,863 and 11/498,269. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 1-72 are provisionally rejected under 35 U.S.C. 101 as claiming the same inventions as that of Claims 1-10 of copending Application No.'s 11/236,863 and

11/498,269. This is a provisional statutory obviousness-type double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same if not very similar inventive concept.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 9-27, 29-36, 38-48, 50-57, 59-61, and 63-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Annunziata (US PG Pub. No. 2001/0034688), [hereinafter Annunziata].

Referring to Claim 1: Annunziata shows a method for creating shares in a commodity, comprising: receiving a creation order comprising a request to create commodity shares (Annunziata: Abstract; Figures 1-2; Page 1, Paragraph 0014; Page 2, Paragraphs 0026-0028) confirming delivery into an account of an amount of commodity associated with the commodity shares being requested (Annunziata: Abstract; Figures 1-3; Page 1, Paragraph 0014); and releasing the requested

commodity shares based upon the amount of commodity delivered into the account (Annunziata: Abstract; Figures 1-3; Page 1, Paragraph 0014).

Referring to Claim 2: Annunziata discusses a method further comprising the step of acknowledging receipt of the creation order (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 3: Annunziata teaches a method further comprising the step of sending a notice of pending commodity delivery to a custodian of the account (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 4: Annunziata discloses a method further comprising the step of confirming receipt of the notice of pending commodity delivery (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 5: Annunziata shows a method, wherein the value of the shares released is approximately equal to the value of the commodity delivered into the account (Annunziata: Page 3, Paragraphs 0029-0031).

Referring to Claim 6: Annunziata teaches a method further comprising receiving a reconciliation from the custodian (Annunziata: Page 3, Paragraphs 0029-0033).

Referring to Claim 9: Annunziata discusses a method, wherein the creation order comprises a request to create of a minimum amount of shares or a multiple of the minimum amount (Annunziata: Page 3, Paragraph 0033-Page 4, Paragraph 0038).

Referring to Claim 10: Annunziata shows a method, wherein the value of the amount of commodity delivered into the account is not less than a minimum value (Annunziata: Page 3, Paragraph 0033-Page 4, Paragraph 0038).

Referring to Claims 11-18: Claims 11-18 parallel the limitations of Claims 1-6, and 9-10. As such, Claims 11-18 are rejected under the same basis as are Claims 1-6, and 9-10 as mentioned supra.

Referring to Claims 19-27 and 29: Claims 19-27 and 29 reflect the limitations of Claims 1-6, and 9-18. As such, Claims 19-27 and 29 are rejected under the same basis as are Claims 1-6, and 9-18 as mentioned supra.

Referring to Claims 30-36 and 38-40: Claims 30-36 and 38-40 parallel the limitations of Claims 1-6, and 9-18 in that they refer to the redemption of the shares created in the commodity. As such, Claims 30-36 and 38-40 are rejected under the same basis as are Claims 1-6, and 9-18 as mentioned supra.

Referring to Claims 41-48 and 50-52: Claims 41-48 and 50-52 reflect the limitations of Claims 30-36 and 38-40 in that they refer to the redemption of the shares created in the commodity. As such, 41-48 and 50-52 are rejected under the same basis as are Claims 30-36 and 38-40 as mentioned supra.

Referring to Claims 53-57 and 59: Claims 53-57 and 59 parallel the limitations of Claims 30-36, 38-48, and 50-52 in that they refer to the redemption of the shares created in the commodity. As such, Claims 53-57 and 59 are rejected under the same basis as are Claims 30-36, 38-48, and 50-52 as mentioned supra.

Referring to Claim 60: Claim 60 reflects the limitations of Claim 30. As such, Claim 60 is rejected under the same basis as is Claim 30 as mentioned supra.

Referring to Claims 61 and 63-69: Claims 61 and 63-69 reflect the limitations of Claims 30-36, 38-48, and 50-52. As such, Claims 61 and 63-69 are rejected under the same basis as are Claims 30-36, 38-48, and 50-52 as mentioned supra.

Referring to Claims 70-72: Claims 70-72 parallel the limitations of Claims 61 and 63-69. As such, Claims 70-72 are rejected under the same basis as are Claims 61 and 63-69 as mentioned supra.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-8, 28, 37, 49, 58, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annunziata in view of Turk (US Pat. No. 5,671,364), [hereinafter Turk].

Referring to Claim 7: Annunziata teaches the limitations of Claim 1.

Annunziata, however, does not expressly discuss a method, wherein the commodity delivered into the account is gold or gold receipts.

Turk, in a similar environment, shows a method, wherein the commodity delivered into the account is gold or gold receipts (Turk: Abstract; Column 2, Lines 26-67; Claim 2, 3, 9).



At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

Referring to Claim 8: Annunziata discloses the limitations of Claim 1.

Annunziata, however, does not expressly teach a method, wherein the value of the shares released is based on the net asset value of the received gold.

Turk, in a similar environment, shows a method, wherein the value of the shares released is based on the net asset value of the received gold (Turk: Abstract; Claims 1-9).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

Referring to Claims 28, 37, 49, and 58: Claims 28, 37, 49, and 58 reflect the limitations of Claim 7. As such, Claims 28, 37, 49, and 58 are rejected under the same basis as is Claim 7 as mentioned supra.

Referring to Claim 62: Annunziata shows the limitations of Claim 61.

Annunziata, however, does not expressly teach a method, wherein said commodity is gold or another precious metal.

Turk, in a similar environment, discusses a method, wherein said commodity is gold or another precious metal. (Turk: Abstract; Claims 1-9).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pritchard (US PG Pub. No. 2002/0046154) teaches a system and method for developing and administering investment trusts.

Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY through THURSDAY, 9AM to 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields

8 January 2008

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
*Art 3692*